

**BRIEF FOR APPELLEE DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

United States Court of Appeals
for the Federal Circuit

No. 2006-1449
(Serial no. 09/499,069)

IN RE TED EUGENE WRIGHT

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences

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STATEMENT OF RELATED CASES

- (a) The Director is not aware of any other appeal involving the underlying decision in this case that was previously before this or any other appellate court.
- (b) The Director is also not aware of any pending case in this or any other court that will directly affect, or be directly affected by, this Court's decision in this appeal.

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Appeal from the United States Patent and Trademark Office,
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I. STATEMENT OF THE ISSUE

Wright essentially claims a sheet of paper or other material having (i) perforation lines and (ii) a “slot” cut into it. The perforations are arranged on the sheet to allow it to be torn into two pieces; one piece capable of being used as a registration form, the other piece capable of being folded, in two or fewer folding steps, into a key-card packet. Dependent claim 6 has been allowed because it includes limitations directed to a specific arrangement of perforation lines that distinguishes Wright’s sheet over the prior art, *i.e.*, a vertical perforation line bisecting the sheet and two horizontal perforation lines perpendicular to the vertical line. The Board maintained the rejection of claims

1, 11, and 16, however, since these claims fail to distinguish over the prior art.

The issue on appeal is whether the Board's rejection of these three claims is correct; specifically:

- a) whether the Board's interpretation of the claims is reasonable;
- b) whether substantial evidence supports the Board's finding that the prior art teaches the perforated sheet and die-cut slot called for in the claims at issue; and
- c) whether the Board properly found that Wright's evidence of secondary considerations is unpersuasive.

II. STATEMENT OF THE CASE

This case concerns Wright's patent application, serial no. 09/499,069, directed to a sheet of paper or other material having perforation lines and a die-cut slot. A43-63.¹ The examiner rejected claims 1-5, 7 and 11-21 as obvious over Thompson in view of other prior art. A121-33 (Ex. Ans.). Claim 6, however, has been deemed allowable if rewritten in independent form. *Id.* The Board affirmed the examiner's rejections since the rejected claims fail to distinguish over the prior art. A1-14. Wright now appeals the Board's decision to this Court.

¹ Citations to the Appendix will be referred to as "A __," and citations to the Wright brief will be referred to as "Br. at __."

III. STATEMENT OF THE FACTS

A. The Claimed Invention

At issue in this appeal are representative claims 1, 11, and 16. All of these claims relate to a single sheet of paper or other material having (i) perforation lines and (ii) a slot or cut out. Representative claim 1 states:

A rectangular, single-sheet registration form and key packet comprising:

a registration form;

an unfolded key packet separated from the registration form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps; and

one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet.

A187. While the preamble of claim 1 recites a “rectangular” sheet, the specification teaches that this shape is not an important aspect of the invention:

In the above example, the single-sheet registration form and key packet is rectangular, but, in *alternative embodiments*, the single-sheet registration form and key packet may be square, or *may have any number of different shapes*.

A50 (emphasis added).

Representative claims 11 and 16 (i) omit the “rectangular” term from the preamble, but (ii) include a functional limitation directed to the ability of the claimed sheet to be fed through a “commercially available” computer printer.

A188-89. However, the specification does not teach any particular physical characteristics needed for a sheet of material to be fed through a “commercially available” computer printer; nor does the specification describe what the applicant considers to be the capabilities of the computer printers that were commercially available at the time the application was filed. Instead, the application teaches that the product need not have any particular dimension to be printed with a laser printer, and acknowledged that different printers have different capabilities.

[D]ifferent sizes of single-sheet registration form and key packets may be used, depending on the needs and desires of the registering organization and on the capabilities of laser printers or other automated printing devices. . . .

A50 (emphasis added).

Figure 2 (shown on the facing page) depicts the preferred embodiment of the claimed invention. A45, A47, A56. Blank sheet **200** includes horizontal perforation line **204** (at the top), segmenting the registration-form portion **206** from the unfolded-key-pocket portion **208**. A second horizontal perforation line

210 (at the bottom) and vertical perforation line **202** (down the center) provide fold lines for construction of a key packet. Blank sheet **200** also includes a die-cut slot **212** into which a magnetic key card, for example, may be inserted.

Figures 5-8 of the application (shown on facing page) depict the detachment of registration form **206** from unfolded key packet **208**, and the subsequent folding of the packet. A59-62. After registration form **206** is torn from unfolded key packet **208**, the lower part **602** of unfolded key packet **208** is folded behind the upper portion along horizontal line of perforations **210**. A49, A60-61. Next, the left side of the packet is folded along vertical line of perforations **202** onto the right side of the packet. A49, A62. Figure 9 shows a magnetic key card inserted into slot **212**. A63.

B. The Prior Art

The Board relied on three references: Thompson, U.S. Patent No. 3,655,110 ("Thompson") in view of Skelton, U.S. Patent No. 4,850,611 ("Skelton") and in further view of Crowell, U.S. Patent No. 4,592,573 ("Crowell"). A123-28.

1. Thompson

Thompson (A16-19) discloses a "unitary blank **12**," which is an unfolded

single sheet of paper stock. A17 (Figures 1, 2, shown on facing page); A18 (col. 1, lines 61-65). The single sheet of Thompson contains three “score lines” (30, 36, and 40) dividing the sheet into four sections: panels 14, 16 and 18, and flap 20. *Id.* Score line 40 runs between Panel 18 (on the right side of the sheet) and panel 14 (in the middle of the sheet); Panel 18 is thus capable of being torn from the remainder of the unitary blank along score line 40. *See id.* Panels 14, 16, and flap 20 can be folded into a packet in two steps: First, panel 16 (on the left side of the sheet) is folded left to right onto panel 14 along score line 30. A18 (col. 2, lines 50-52). Second, flap 20 (on the bottom of the sheet) is folded up onto the outer surface of panel 16 along score line 36, allowing adhesive 38 to adhere to panel 16, thus creating a pocket. A18 (col. 2, lines 52-58). Thompson’s single sheet also contains a slot 42 that is capable of holding baggage claim tickets and other items. A17 (Figures 1, 2); A18 (col. 2, lines 61-64); A19 (col. 3, lines 4-8).

2. Skelton

Skelton is directed to a foldable paper container for tickets and the like. A20 (Abstract). The foldable container includes a plurality of panels of paper or similar material joined by a “weakened hinge line,” such as by “perforation” or “scoring.” The panels are detachable from each other along the weakened hinge

lines. Skelton teaches that score lines and perforations are interchangeable for purposes of folding or separating two portions of a unitary paper product. A24 (Figs 12-13); A26 (col. 2, lines 53-61); A27 (col. 3, lines 61-66).

3. Crowell

Crowell is directed to rectangular folding stationary that can be printed on with a computer printer. A30 (Abstract); A31 (Fig.1); A34 (col. 2, lines 46-51).

C. The Board Decision

The Board first construed claim 1 as comprising a rectangular, single sheet “blank,” where a first portion, designated a “registration form,” is separated from a second portion, designated the “key packet,” by a line of perforations. A5-6. The Board found that, like the claimed invention, Thompson discloses a single-sheet entity: the “unitary blank 12” of Figure 2. A9. The Board further found that the unitary blank 12 contained “score lines” corresponding to the claimed perforation lines. A7-8. Noting that Skelton teaches that score lines and perforations are interchangeable for purposes of folding and separation, the Board concluded that a person of ordinary skill in the art would have found it obvious to substitute the perforations of Skelton for the score lines of Thompson. *Id.* The Board also found that a separable portion of Thompson’s sheet is capable of being folded into a complete packet in two folding steps. A9 (citing

A18, col. 2, lines 49-59). In addition, the Board found that Thompson's die-cut slot is capable of holding keys. A9.

Responding to Wright's argument that Thompson's sheet is "non-rectangular," while claim 1 requires a rectangular single-sheet product, the Board held that "[m]erely changing the shape of a paper form does not render the claimed form patentable, absent some showing of criticality." A6 (citing *In re Dailey*, 357 F.2d 669, 672-73 (CCPA 1966)). The Board noted that Wright's specification teaches that it is not critical that the sheet be rectangular, but rather that it "may have any number of different shapes." A6-7 (quoting A50, lines 10-12). In addition, Wright failed to submit any evidence to show the criticality of the rectangular shape. Accordingly, the Board concluded that Wright did not show that the shape of the invention was sufficiently critical to distinguish it over the prior art. *Id.*

Claims 11 and 16 have no rectangular-shape term in the preamble. However, they do contain the functional limitation that the paper be capable of being fed through a computer printer. The Board affirmed the examiner's rejection of these claims and the examiner's finding that Thompson's sheet could be printed on a laser printer. A4, A127.

Having affirmed the examiner's *prima facie* case of obviousness, the Board considered Wright's evidence of secondary considerations, but found it unpersuasive. The Board found that Wright's sales figures were insufficient to show commercial success in the absence of credible evidence that Wright's invention enjoyed substantial market share. A11-12. The Board rejected Wright's statements concerning his market share as based on his own opinion rather than on substantive evidence. A12. The Board also noted that there was insufficient evidence of a nexus between the sales figures provided and the claimed invention. A11-13. Regarding the evidence purporting to show copying by others, which consisted largely of an email from a subsidiary of Hilton Corporation demanding that the phrase "patent pending" be removed from the products Wright sold to Hilton, the Board noted that it was "mere speculation" that this employee was attempted to facilitate copying of Wright's product by other printers. A13. The Board further observed that there was no direct evidence of actual copying by others. A13-14.

IV. SUMMARY OF THE ARGUMENT

Wright essentially claims a sheet of paper or other material having (i) perforated lines and (ii) a slot. One of Wright's claims – claim 6 – is sufficiently narrow to distinguish over the prior art, since it is limited to a

specific and unique arrangement of the perforations on the sheet. The three representative claims² on appeal, however, are not so limited, and are therefore obvious in light of the prior art, specifically Thompson in view of Skelton. The score lines of Thompson's sheet enable the sheet to be torn into two pieces along one score line; like the claimed invention, one piece can perform the function of Wright's registration form, and the other piece that can be folded in two steps along additional score lines to produce a pocket with a slot for holding a variety of items, including a magnetic key card.

While the sheet of Thompson is not rectangular as recited in claim 1, Wright's own specification indicates that the rectangular shape is *not* critical, and Wright has failed to proffer any persuasive evidence to show otherwise.

Representative claims 11 and 16 are not limited to any specific shape, but rather to products that may be fed through a "commercially available" computer printer. Substantial evidence exists to support the Examiner's and the Board's finding that Thompson's sheet can be fed through a commercially available computer printer.

² Independent claims 1, 11, and 16 are at issue. Wright does not separately argue the patentability of dependent claims 2-5, 12-15, and 17-21. Thus, the dependent claims stand or fall with the independent claims.

Finally, Wright's evidence of secondary considerations is insufficient to overcome the *prima facie* case of obviousness. Wright's raw sales figures do not establish commercial success in the absence of evidence showing that Wright's product enjoys significant market share. Further, Wright has provided no actual evidence of copying.

V. ARGUMENT

A. Standard of Review

The ultimate issue of obviousness is a legal question based on underlying factual findings. *See In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000).

What the prior art teaches is a question of fact. *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1088 (Fed. Cir. 1995). Similarly, whether a person of ordinary skill in the art would have been motivated to combine references is a question of fact. *Gartside*, 203 F.3d at 1316.

On appeal, the Board's factual findings are reviewed for substantial evidence. *Id.* at 1315. Substantial evidence "means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion."

Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229 (1938). "[T]he possibility of drawing two inconsistent conclusions from the evidence does not prevent an administrative agency's finding from being supported by substantial

evidence.” *Consolo v. Fed. Mar. Comm’n*, 383 U.S. 607, 620 (1966) (citation omitted).

Claim interpretation is a question of law reviewed *de novo* on appeal. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998) (*en banc*). However, since claims during prosecution must be given their broadest reasonable interpretation consistent with the specification, this court reviews the USPTO’s claim interpretation to determine whether it is “reasonable in light of all the evidence before the Board.” *In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir. 1997).

B. The Board Correctly Held That the Examiner Had Made out a Prima Facie Case of Obviousness for Claim 1

1. Wright’s Claim to a Sheet of Paper with Perforations and a Slot Would Have Been Obvious in View of the Prior Art

The Board correctly found that claim 1 would have been obvious in view of Thompson and Skelton. Claim 1 (as well as the other asserted claims) recites a sheet of paper or other material with (i) perforation lines and (ii) a slot. A2, A56, A187. Thompson discloses a sheet of paper stock containing (i) “score lines” – which Skelton teaches are interchangeable with perforations; and (ii) a slot.

As depicted in Figure 2 of Thompson (shown on facing page), sheet 12 is divided into panels 14, 16, and 18, and flap 20, by score lines 30, 36, and 40. A17 (Figure 2); A18 (col. 1, lines 62-66; col. 2, lines 25-28). Score line 40 runs between panel 18 (the right side of the sheet) and panel 14 (the middle of the sheet). *Id.* Skelton teaches that score lines are interchangeable with perforations, in that both are equally useful for purposes of folding or separation. A20 (Abstract), A26 (col. 2, lines 55-61).³ Panel 18 is thus capable of being detached from the remainder of the sheet and performing the function of Wright's registration form. Further, as noted in Wright's specification and drawings, the claimed registration form can be completely blank. A45, A47, A56. Panel 18 thus corresponds to Wright's claimed registration form. *See* A123 (Ex. Ans. at 3).⁴

³ Wright does not dispute, in his opening brief, the Board's characterization of Skelton's teachings. Nor does Wright argue the absence of the requisite motivation to combine Skelton with Thompson. Thus, Wright has waived these arguments on appeal. *Novosteel SA v. United States*, 284 F.3d 1261, 1274 (Fed. Cir. 2002). Regardless, Skelton itself provides the motivation to combine when it teaches that perforations and score lines are interchangeable. *See In re Johnston*, 435 F.3d 1381, 1386 (Fed. Cir. 2006) (prior art teaching of two interchangeable alternatives provides necessary motivation for an artisan to substitute one alternative for the other).

⁴ In her Answer the Examiner refers to panel 18 by the number (26) corresponding to the inner face of panel 18. A123; A18 (Thompson, col. 1, lines

Moreover, panels **14**, **16** and flap **20** can be folded into a packet in two steps. First, panel **16** (the left side of the sheet) is folded left to right onto panel **14** along score line **30**. A18 (col. 2, ll. 48-51). Second, flap **20** (at the bottom of the sheet) is folded up onto panel **16** along score line **36**. A18 (col. 2, ll. 51-53). At this point adhesive **38** automatically binds flap **20** to panel **16**, thereby creating a pocket in two steps. A9 (Bd. Dec., citing Thompson, A18, col 2, ll. 49-59).

Finally, the blank sheet of Thompson contains a slot **42**. This slot is shaped and sized to receive a baggage claim ticket and “a wide range of items.” A18-19. Wright has acknowledged that slot **42** of Thompson is capable of holding a baggage claim ticket (A182), which is the same general size and shape of a magnetic key card. *Compare* A17 (Figure 1) *with* A63 (Figure 9) (shown on facing page). Thus, slot **42** of Thompson corresponds to the die-cut slot of claim 1 and Thompson, in view of Skelton, discloses all of the elements common to the asserted claims. A8-9.

65-70); *see also* A4 (Board Decision quoting Examiner’s Answer).

2. The Limitation in Claim 1 That the Single Sheet Product Be “Rectangular” Is Insufficient to Patentably Distinguish Claim 1 from the Prior Art

Claim 1 additionally recites in the preamble that the unfolded single-sheet product be rectangular. A187. But limitations drawn to the shape of a product cannot overcome an obviousness rejection unless the particular shape employed is significant or critical to the invention’s functionality. *See, e.g., In re Elbert*, 373 F.2d 534, 536 (CCPA 1967) (claimed spinneret plate not patentably distinct from prior art despite having differently shaped extrusion orifices since claimed orifice shape one of numerous choices one of ordinary skill would find obvious); *In re Dailey*, 357 F.2d 669, 672-73 (CCPA 1966) (claimed nursing container not patentably distinct from prior art despite having a different shape since claimed container shape is one of numerous shapes a person of ordinary skill in the art would find obvious); *In re Hanlon*, 285 F.2d 829, 831 (CCPA 1961) (claimed tape dispenser not patentably distinct from prior art despite having a differently shaped tearing edge since tearing-edge shape not shown to be significant); *see also Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 1349 (Fed. Cir. 1984) (claimed paper-drying device not patentably distinct from prior art despite having differently dimensioned air jets since dimensional limitation not shown to result in a device that performs differently from prior art).

This makes sense, for if the shape of a product does not significantly affect the functional capabilities of a product, the shape is merely an element of the product's design. See Manual of Patent Examining Procedure ("MPEP") § 1502 (the shape of an article is one possible aspect of the article's design); *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378 (Fed. Cir. 2002) (a design is ornamental if different designs could produce the same or similar functional capabilities). Design features cannot be sufficient to overcome an obviousness objection because, otherwise, anyone could obtain a patent monopoly on an old product merely by changing the appearance or shape of the product without making a meaningful contribution to the relevant art.

As the Board aptly recognized, A7 n.4, it is clear from Wright's own disclosure that the rectangular shape recited in claim 1 is not significant to the functionality of Wright's invention. Wright states there that the single sheet of his invention need *not* be rectangular but "may have any number of different shapes." A50. Moreover, as discussed below, there is no credible evidence in the record suggesting otherwise. The Board, relying on the *Dailey* decision (357 F.2d at 672-73) correctly held that the shape of the paper does not render the claims patentable. A6.

In *Dailey*, the invention at issue was a disposable nursing container for infants. Two of the claims at issue differed from the prior art only in terms of the particular container shape recited. *Id.* at 670. The *Dailey* court affirmed the Board's conclusion that the shape of the claimed container was "a mere matter of choice not significantly novel" over the prior art:

Appellants have presented no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the collapsed container of [the prior art].

Id. at 672-73.

Wright argues that the Board misread and misapplied *Dailey*. Wright first contends that, contrary to the Board's characterization, *Dailey* does not require a showing that shape is critical, but only a showing that it is "significant." Br. at 20. There is no legal difference between criticality and significance in this context, however, as suggested by this Court's predecessor. *See Elbert*, 373 F.2d at 536 ("[a]ppellants have presented no evidence or argument which convinces us that the [shape] of the orifice is *significant or critical*" (emphasis added)). In any event, Wright cannot show that the rectangular-shape limitation is either critical *or* significant, since Wright teaches that the invention may be any of a number of shapes besides rectangular. A50.

Wright also seems to contend that *Dailey* does not apply to the art of “paper forms,” but only to nursing containers. Br. at 20. This argument is also unpersuasive, since the principle for which the Board has cited *Dailey* – that shape alone is insufficient to patentably distinguish a claimed invention over the prior art in the absence of some showing that a shape limitation is significant – has been applied in a number of different contexts. *See Elbert*, 373 F.2d at 536 (textile filament extrusion spinnerets); *Hanlon*, 285 F.2d at 831 (surgical tape dispensers).

Wright further argues that the rectangular-shape limitation is critical: He alleges that his invention must be rectangular so that it can be fed through a commercially available laser printer. Br. at 21-27. However, the bulk of this discussion is attorney argument rather than evidence. For example, Wright discusses, without citation to the record, the feed-tray mechanism that laser printers “normally” have. Br. at 25-26. Wright’s unsupported attorney argument is insufficient to show that Wright’s rectangular-shape limitation is a significant aspect of his invention. *See Gardner*, 725 F.2d at 1345 (“TEC’s contentions in this regard are no more than unsupported argument of counsel, and for that reason unpersuasive”).

Moreover, it is too late now for Wright to contradict his own written description, which is supposed to describe the claimed invention in “full, clear, concise and exact terms.” 35 U.S.C. § 112, ¶ 1; *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*); *see also In re Smith*, 183 F.2d 84, 87 (CCPA 1950) (teachings of specification control over contradictory affidavit). While Wright makes clear in his specification that his invention is intended to be printed on a laser printer or other computer printer, he also teaches that his invention need not be rectangular. A50. It follows that Wright teaches in his specification that his invention need *not* be rectangular in order to be fed through a computer printer. His attempt to now argue otherwise contradicts the teaching of his specification and should, therefore, be rejected.

3. Wright’s Arguments Misapprehend the Teachings of Thompson as Well as the Breadth of the Appealed Claims

Wright argues that Thompson does not disclose a single sheet product, but rather an article manufactured from two separate pieces: the unitary blank 12 with glassine sheet 44 bonded to it. Br. at 27-28. This is incorrect. The Board relied only on the die-cut unitary blank 12 of Thompson without the glassine sheet in its analysis. A9. Moreover, as the Board correctly recognized, claim 1 uses the transitional term “comprising,” “which opens the claim to *additional*

elements.” A5 n.3 (emphasis added) (citing *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997)); *see also Dow Chemical Co. v. Sumitomo Chemical Co.*, 257 F.3d 1364, 1380-81 (Fed. Cir. 2001). Accordingly, the Board correctly construed claim 1 as including “*at least* a rectangular, single-sheet blank,” which permits other elements like Thompson’s glassine sheet to be included with the claimed structure. *See* A5.

Wright also argues that Thompson does not disclose a “registration form.” This, too, is incorrect. The Board, giving the claim terms their broadest reasonable construction consistent with the specification, construed “registration form” to be a portion of the claimed blank sheet that is capable of being detached from the remainder of the blank sheet. A5-6. This construction is reasonable, since one of Wright’s embodiments shows the registration form to be just that: a portion of a blank sheet of paper detachable from the remainder of the paper. A47 (describing the blank, perforated sheet of paper depicted in Figure 2, at A56, as showing a “single-sheet registration form and key packet **200**,” which includes “registration form **206**”).

Wright suggests that his claimed registration form must bear certain printed matter on it. Br. at 36. This is incorrect. First, as noted above, the specification specifically identifies a blank sheet as an embodiment of the claimed

invention. A47, A56. Second, claim 1 does not specifically require printed matter. Third, claim 1 cannot be interpreted as requiring printed matter because claims that depend from it specifically recite the presence of printed matter.

A187-190. Thus, under the doctrine of claim differentiation, claim 1 is presumed not to contain this limitation. *See Phillips*, 415 F.3d at 1314-15 (holding that presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim). Finally, one commercial embodiment of the invention, the sale of which Wright relies to show commercial success, is itself a blank sheet. A336 (email noting that blank forms are sold to Sheraton and other chains). This demonstrates that Wright is of the view that his registration form need not have printed matter on it.

Wright further argues that there is no disclosure in Thompson of an unfolded key packet that can be folded into a complete packet in two or fewer steps. Rather, Wright argues, Thompson's unfolded ticket envelope requires more than two steps to manufacture, including the bonding of a glassine sheet of material to the unitary blank and the use of adhesive to bond flap 20 to panel 16. Br. at 30-31.

In this regard, however, Wright is wrong. First, as noted above, the glassine material is not part of the disclosure that the Board relies upon to show obviousness. Rather, the Board relies only on the unitary blank 12, which includes panels 14, 16 and 18, and flap 20. Therefore, the glassine material is not part of the rejection. Second, during the second folding step, the folding action necessarily and automatically causes adhesive 38 on flap 20 to bond to panel 16. Therefore, the adhesive bond is not a separate step but rather a part of the second folding step. In any event, while the specific embodiment of Wright does not use adhesive, there is no teaching in Wright that the use of adhesive is outside the scope of the invention as a whole; thus, it is not unreasonable to define the two-or-fewer-steps limitation as proscribing additional *folding* steps, not the use of adhesives. *See Morris*, 127 F.3d at 1056 (“[a]bsent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO’s definition unreasonable”).

Finally, Wright argues that “Thompson does not teach, mention, or even suggest that Thompson’s elongated opening or slot 42 is capable of holding any object.” Br. at 33. This argument, however, is in direct conflict with Wright’s admission to the Board that “Thompson’s slot is shaped and sized to hold a

baggage claim ticket.” A182. Indeed, Thompson shows slot 42 receiving and holding a baggage claim ticket 52. A17 (Figure 1, shown on facing page). The baggage claim ticket held in the slot of Thompson is of the same general size and shape as the magnetic key card shown being held by Wright’s slot. *See, e.g.*, A63 (Figure 9); A444 (describing Figure 9 as illustrating insertion of a room key card into a key card slot within a key packet). Hence, the Board’s conclusion that the slot of Thompson is capable of “hold[ing] a number of keys in the complete key packet” is supported by substantial evidence. *See In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997) (since prior art device and claimed device had same general shape, examiner was justified in concluding that prior art structure was capable of performing claimed function).

Wright claims that the Board erroneously shifted the burden to him to show that Thompson’s slot does not disclose the claimed slot. Br. at 33. This is incorrect. The Board found as a factual matter, based on the disclosure of Thompson, that the slot of Thompson does meet this claim limitation. A8. The burden, at that point, did shift to Wright to rebut this finding. *Schreiber*, 128 F.3d at 1478 (once examiner found that prior art structure was capable of performing claimed function, burden shifted to applicant to rebut this finding).

C. Claims 11 and 16 Would Also Have Been Obvious since Thompson's Form Could Be Printed Using a Laser Printer

Unlike claim 1, claims 11 and 16 do not have the term "rectangular" in the preamble. However, they require "a single sheet dimensioned to feed through a commercially available computer printer" (claim 11) or "a single sheet having dimensions, a weight, a texture, and a moisture content that allows the single sheet to be reliably fed through a commercially available computer laser printer." (claim 16). A188-9. The Board adopted the Examiner's finding that Thompson is capable of performing the intended use of being fed through a commercially available computer printer. A4, A127.

The "printability" limitations of claims 11 and 16 were not originally claimed, but were later added to overcome obviousness rejections. This may be one reason why there is essentially no discussion of these limitations in the specification. For example, there is no guidance as to what dimensions are preferred to ensure that the claimed single sheet may be fed through a "commercially available computer laser printer." The specification teaches only that "different sizes of single-sheet registration form and key packets may be used, depending on the needs and desires of the registering organization and on the capabilities of laser printers or other automated printing devices." A50.

Similarly, the specification does not address any preferred weight, texture, or moisture content needed to ensure the printability contemplated by claim 16.

Moreover, the single sheet blank of Thompson is made from paper stock, and is not limited to paper stock having any particular dimension, weight, texture, or moisture content. Therefore, the Board's finding that the unitary blank of Thompson is capable of being fed through a commercially available laser printer is supported by substantial evidence. *See Schreiber*, 128 F.3d at 1478-9 (concluding that since the prior art conical oil-can top was "same general shape" as claimed popcorn-container top, examiner was justified in concluding that prior art top could perform same function as claimed top).

The burden is thus on Wright to show that Thompson's unitary blank is incapable of being fed through a commercially available laser printer. *Id.*; *see also In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971) (holding that PTO has authority to require applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon to establish patentability of claimed subject matter). Wright first argues that Thompson does not teach or suggest the dimension, moisture content, weight, or texture limitations contained in claims 11 and 16. Br. at 30. However, if a prior art structure is inherently capable of performing a claimed function, it is irrelevant whether the function is

expressly disclosed in the prior art. *See id.* (“recitation of a new intended use for an old product does not make a claim to that old product patentable”).

Wright next points to his July 17, 2003 declaration and attached exhibits (A224-233) as evidence that Thompson cannot be fed through a laser printer. Br. at 30.

However, neither this declaration nor the attached exhibits indicate that Wright ever tried to feed Thompson’s sheet through a laser printer, and thus they fail to rebut the Board’s finding that the structure of Thompson can be fed through a laser printer.

D. The Board Correctly Held That Wright’s Evidence of Secondary Considerations Was Insufficient to Overcome the Prima Facie Case of Obviousness

Having affirmed the examiner’s *prima facie* case of obviousness of claims 1, 11, and 16, the Board carefully considered Wright’s evidence of alleged commercial success and copying by others, and re-evaluated the examiner’s evidence for obviousness against this evidence. A10-14. Having done so, the Board correctly determined that Wright’s evidence of secondary considerations did not outweigh the evidence of obviousness relied upon by the examiner.

1. The Inventor's Declaration Has Not Shown That His Invention Is Commercially Successful

Wright's evidence of commercial success consists of a personal declaration that contains: (1) sales figures from 2000 through the first five months of 2002; and (2) his personal opinion that his invention enjoyed 99% of the market. A329-30. As the Board correctly found, this declaration deserves little if any weight, since it (i) provides only raw sales numbers; (ii) does not define the relevant market; and (iii) fails to establish the requisite nexus between the sales and the claimed product.

First, as the Board noted, Wright's raw sales figures, by themselves, are insufficient to establish commercial success. A11 (citing *In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991); *see also In re Huang*, 100 F.3d 135, 139-140 (Fed. Cir. 1996). In *Huang*, the applicant attempted to overcome a *prima facie* case that his claimed tennis-racquet grip was obvious with evidence that, *inter alia*, he had sold over one million grips to Wilson Sporting Goods and other companies. *Huang*, 100 F.3d at 137. The Court determined, however, that this evidence was insufficient to establish commercial success.

Acknowledging that "many units were sold," there was no indication that the number "represents a substantial quantity in this market." *Id.* at 140. In the

absence of any reliable market-share evidence, sales figures provide “a very weak showing of commercial success, if any.” *Id.* (citations omitted).

The evidence presented by Wright in the present case is no stronger than that rejected by the Court in *Huang*. Like in *Huang*, Wright’s sales figures do not, in themselves, establish commercial success, since the record fails to show that Wright’s sales represent a substantial percentage of the market. Wright’s opinion that “I feel that my [product] currently enjoys 99% of the current market” (A330) does not cure this defect. As the Board correctly noted, that opinion is unsupported by substantive economic evidence. A12. The Board also observed that, while the record includes order forms for two competing businesses (A224-5), Wright does not provide any concrete economic evidence as to the market share held by these or any other companies. A12. As the Court stated in *Huang*, “the PTO lacks the means or resources to gather evidence which supports or refutes the applicant’s assertion that the sales constitute commercial success. . . . Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.” *Huang*, 100 F.3d at 139-140. Wright’s opinion is far from hard evidence of market share, and the Board justifiably gave it little weight.

Wright also appears to be mistaken as to what constitutes the relevant market. Wright apparently believes the relevant market to be composed of only those products that practice his invention. *See* A330 (“[s]ince my [invention] is a new product, and since only relatively recently have two potential infringers begun to copy and market copied versions of my [invention], I feel that my [invention] currently enjoys about 99% of the current market”). This is incorrect. The relevant market must include not only products that practice the invention, but also competing products. *See In re Mageli*, 470 F.2d 1380, 1384 (CCPA 1973) (relevant market includes the claimed invention, SBP, plus a competing product, IPP).

Finally, Wright does not show the requisite nexus between sales of products that embody his invention and “the unique characteristics of the claimed invention,” as opposed to “other economic and commercial factors unrelated to the quality of the patented subject matter.” *Huang*, 100 F.3d at 140. For example, Wright’s sales could be the result of price concessions rather than any specific advantage of the claimed subject matter. In the absence of any showing of nexus, Wright’s commercial success is not relevant to the obviousness inquiry.

2. Wright Has Not Shown Any Significant Copying of His Invention

The Board also considered Wright's evidence purporting to show copying of his invention by others, but correctly found that evidence to be unpersuasive.

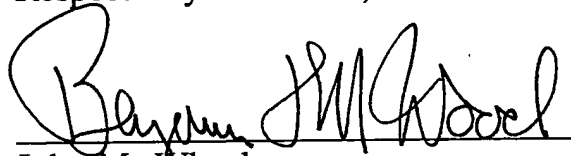
A13. Wright first points to an email in which an employee of Hilton Hotels allegedly forced him to remove a "patent pending" label from the product he was selling to Hilton. A336-7. Wright alleges that the purpose of this attempt was to facilitate the copying of his invention by others. Br. at 49. However, as the Board pointed out, the employee's stated purpose for doing so was to enforce a Hilton policy against its suppliers advertising on Hilton-marked products. A13. In fact, the label in question contained more than "patent pending;" it also contained the name and phone number of Wright's company, Electronic Forms Plus. A343. Thus, there is no hard evidence to support Wright's speculation that this email is evidence of copying by others. Moreover, Wright has stated that he sells his products to "many different hotel chains." A330. Wright does not allege that any other hotel chain attempted to facilitate copying of his invention, as he alleges with respect to Hilton. Thus, to the extent this email is considered evidence of copying, it would not appear to be a widespread problem.

Wright also points to two advertisements in which competitors are purportedly advertising copies of Wright's invention. A334-5. However, there is no indication of actual sales resulting from these advertisements. Accordingly, the Board correctly found this evidence to be unpersuasive. A13-14 ("there is no substantive evidence of product copying").

VI. CONCLUSION

Since the Board correctly found that representative claims 1, 11, and 16 would have been obvious pursuant to 35 U.S.C. § 103, this Court should affirm that decision.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John M. Whealan", is written over a horizontal line.

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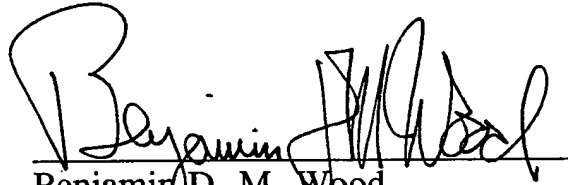
*Attorneys for the Director of the
United States Patent and
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October 16, 2006

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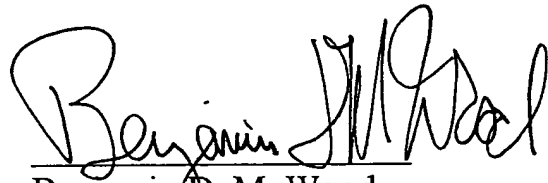
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I certify pursuant to FRAP 32(a)(7) that the foregoing brief complies with the type-volume limitation. The total number of words in the foregoing brief, excluding the table of contents and table of authorities, is 6486, as calculated by the WordPerfect 11 program.


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